

Notice of Allowability

Application No.

10/000,448

Examiner

Gary Hartmann

Applicant(s)

WILEY, PATRICK CARL

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 7/29/5.
2. ☒ The allowed claim(s) is/are 1-25.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 7/29/5, 8/12/5
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Thomas W. Bailey on October 26, 2005.

The application has been amended as follows:

Claim 1, line 6, ":" has been deleted and replaced with --;--;

Claim 1, line 7, "having a predetermined pattern" has been deleted and replaced with -- pre-formed as a grid --;

Claim 20, line 7, ":" has been deleted and replaced with --;--;

Claim 20, lines 8-9, "in a predetermined pattern" has been deleted and replaced with -- as a grid--;

Claim 20, lines 10-11, "in said predetermined pattern" has been deleted and replaced with -- as said grid--;

Claim 25, line 6, ":" has been deleted and replaced with --;--;

Claim 25, lines 7-8, "in a predetermined pattern" has been deleted and replaced with -- as a grid--;

Claim 25, lines 10-11, "in said predetermined pattern" has been deleted and replaced with -- as said grid--.

The following is an examiner's statement of reasons for allowance: impressing a template into an asphalt surface in a grid pattern is well known, as exemplified by Stowell et al. (U.S. Patent 5,215,402). Placing material into the impression made by a template is also known. Typically, this is done by placing a flowable material therein, as exemplified by Cata-Groove and Walden (WO 87/02724). The material flows such that the impression is filled as desired. While this works to fill the impression, placing a flowable material is patentably distinct from placing a pre-formed grid.

It is also known to position a pre-formed material into an impression in asphalt. Stamark™ pavement marking tape is an example of a pre-formed material which is taught to be inserted into an impression, as discussed by Caven et al. (U.S. Patent 5,857,453). Both Caven et al. and the 3M Guidelines for applying Stamark™ Pavement Marking Tape teach cutting grooves, rather than impressing a template.

Given the combined teachings of Stowell et al., Caven et al. and the 3M Guidelines for applying Stamark™ Pavement Marking Tape, it is the examiner's opinion that it would have been within ordinary skill to have placed linear or nearly linear segments of pavement marking tape into a pre-formed grid impression; however, there is no teaching that would have led one skilled in the art to have pre-formed a grid of material and subsequently placed the grid as claimed. In other words, because pre-forming a grid would have been more complicated and difficult to handle than laying linear or nearly linear segments into an impression, prior art teachings would have led one skilled in the art to have filled (in whole or in part) a prior art impression by either placing linear or nearly linear segments, or by filling the impression with flowable material, as discussed above. Similarly, in instances in which an impression is made in

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the form of a grid having non-linear segments; for example, Puccini et al. (U.S. Patent 4,135,840), it is the opinion of the examiner that the prior art would have led one skilled in the art to have either used tape segments or to have placed flowable material into the impression; not to have preformed a grid.

While there are teachings of material for placement on paving surfaces that can be within the scope of the term grid (for example, Bensen, U.S. Patent 2,196,890 provides sufficient teaching for it to have been within ordinary skill to have pre-formed a grid), these teachings lack discussion regarding making impressions with a template prior to insertion of the grid. These grids are typically placed on a flat (i.e., not impressed) pavement surface. For the reasons discussed above, it is the opinion of the examiner that, in order to make the rejection based on the obviousness of insertion of a prior art grid (e.g., Benson) into an impression made by a prior art template (e.g., Stowell et al.), excessive hindsight would have been necessary. There is also no teaching of a prior art impressing device that might make a sufficiently large, uninterrupted impression in the manner claimed to fit an entire piece of prior art material that is within the scope of the term grid; therefore, this rejection has not been made.

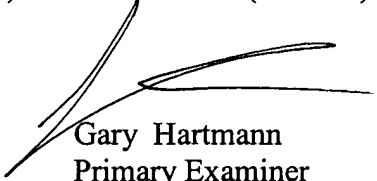
In summary, there is no teaching for one skilled in the art to have pre-formed pavement marking tape, or any other material, into a grid and subsequently fixed the grid into an impression formed in the manner claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 571-272-6989. The examiner can normally be reached on Monday through Thursday, 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Hartmann
Primary Examiner
Art Unit 3671

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